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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/822,049

04/10/2004

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01/04/2007

EXAMINER

MAKI, STEVEN D

ART UNIT

PAPER NUMBER

1733

MAIL DATE

DELIVERY MODE

01/04/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

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<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/822,049</p>	<p>Applicant(s) ROSENBERGER, RONALD JOHN</p>	
	<p>Examiner Steven D. Maki</p>	<p>Art Unit 1733</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 December 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 08 December 2006. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see advisory action attachment. (See 37 CFR 1.116 and 41.33(a)).

4. ☒ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1,2,4-10,12,13,16 and 17.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see advisory action attachment.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☒ Other: Notice of Non-Compliant Amendment.

ADVISORY ACTION ATTACHMENT

new issues

The new issues include:

- (1) In claims 1, 2, 4-10, 12-13, 16 and 17, adding --scented-- before "vehicle tire" in the preamble;
- (2) In claims 1, 2, 5, 6, 7, 9, 10, 12, 13, 16 and 17, deleting --o-ring--;
- (3) In claim 1, adding "incorporated into";
- (4) in claim 1, changing "at least one removable insert, o-ring or plug" to --at least one removable insert or plug-- while simultaneously adding "incorporated into said insert, o-ring or plug"; and
- (5) In claim 10, deleting --or b. comprises any embodiment of an "O" ring around the circumference or diameter of said vehicle tire--.

In claim 6, the deletion of --void,-- and --, or a groove, channel, or crevice-- does not raise a new issue.

request to removal finality of last office action

Applicant requests that the final status of the present Office Action be removed, due to the fact that the Examiner has made new prior art rejections using different art and different combinations of art. This request is denied because each of the rejections made in the last office action was necessitated by applicant's amendment filed 6-16-06. Claim 1 for example was subject to extensive amendments including:

- (1) deletion of the subject matter of "where said novelty scented rubber compound and/or said novelty scented non-rubber component gives off a unique aroma when said tire is a rest" and
- (2) deletion of the subject matter of "where normal wear of said vehicle tire exposes fresh surface area of said novelty scented rubber compound, and/or said novelty scented non-rubber component, wherein said unique aroma comprises a salient, distinctive, and marketable feature of said vehicle tire" and
- (3) addition of the subject matter of "at least one removable insert, o-ring or plug provided in at least one void contained adjacent to the outside of at least one of a tread, a belt, or a ply of said vehicle tire" and
- (4) addition of the subject matter of "said insert, o-ring or plug comprising at least one scent or fragrance".

The above amendments simultaneously broadened and narrowed claim 1 to require a new combination, which was not present in any of the original dependent claims. With respect to the application of Great Britain 584, the amendment to broaden claim 1 was no minor matter in this application as it resulted in a claim which reads on the natural scent of rubber of a tire instead of the various disclosed scents of lemon, orange, cherry, cinnamon, beer, chocolate, etc. Each of the rejections set forth in the final office action dated 9-8-06 were necessitated by the above noted extensive amendments to claim 1. See MPEP 706.07(a).

remarks

Applicant comments that the claims have been amended to clarify the tires have an added scent or fragrance and release an added scent or fragrance, which does not include the smell of the rubber being heated or oxidized. This comment is irrelevant since neither the claims in the amendment filed 6-16-06 nor the claims in the after final amendment filed 12-8-06 describe a tire having an added scent or fragrance and release of the added scent or fragrance, which does not include the smell of the rubber being heated or oxidized.

With respect to the objection to claim 10, it is noted that claim 10 is not compliant with rule 1.121 and that claim 10 filed 6-16-06 removed (instead of added) the removable limitation by making the removable limitation optional.

With respect to claim 1, applicant comments and examiner agrees that terms such as novelty, unique aroma, and salient, distinctive and marketable features were rejected as being indefinite. The examiner adds that instead of amending claim 1 by adding language to clarify the characteristics of the scented compound / component, applicant took the drastic and unexpected action of simply deleting "said novelty scented rubber compound and/or said novelty scented non-rubber component gives off a unique aroma when said tire is a rest" and "where normal wear of said vehicle tire exposes fresh surface area of said novelty scented rubber compound, and/or said novelty scented non-rubber component, wherein said unique aroma comprises a salient, distinctive, and marketable feature of said vehicle tire".

Great Britain 584

Applicant argues that Great Britain 584 fails to teach an *added* scent or fragrance *compound* and directs attention to the disclosure which describes incorporating novelty scent or fragrance in rubber compound(s). This argument is not commensurate in scope with the claims and is therefore not persuasive since none of the claims require a composition comprising two compounds wherein one compound is a scent or fragrance compound and the other compound is a rubber compound(s).

With respect to Great Britain 584, applicant refers to "the use of scent as a tire wear indicator". Examiner comments that claim 1 describes "said insert, o-ring or plug comprising ... scent..." instead of excluding the use of a tire wear indicator which is flush with the surface of the tread as in Great Britain 584. See page 3 lines 21-26 of Great Britain 584. Applicant has provided no convincing argument as to why such a rubber tread wear indicator does not have a scent during "use" of the tire. As explained in the last office action, Great Britain 584's rubber wear indicator, like all rubber, inherently has a scent.

Applicant argues that Korea's use of encapsulated fragrance as a wear indicator to be activated at the time the tire needs to be replaced does not make up the deficiencies of Great Britain 584. This argument is not persuasive. First: Claim 1 fails to require the tire to have the capability of release of the scent before the time the tire needs to be replaced. In particular, claim 1 fails to require fragrance compound and rubber compound at the tread surface of a new tire such that the scent is released when the tire is used for the first time. Second: Great Britain 584's wear indicator 10 is worn

when "said tire is used for driving" and Korea motivates one of ordinary skill in the art to use smell (scent) to indicate wear of a tire.

Applicant argues that Japan 873 does not recite a plug, insert or o-ring. More properly, Great Britain 584 teaches a "removable insert" (wear indicator 10) as being part of the tire tread and Japan 873 (published 4-16-02) shows that a tire tread which releases a scent due to wear when the tire is used in a vehicle for driving was known in the tire art prior to applicant's filing date (4-10-04).

Applicant argues that German 356 fails to suggest that the smell can be emitted whenever the tire is exposed to normal use. This argument is not persuasive. First: Claim 1 fails to require that the scent be emitted whenever the tire is exposed to normal use. Second: Great Britain 584's wear indicator 10 is worn when "said tire is used for driving" and German 356 motivates one of ordinary skill in the art to use smell (scent) to indicate wear.

At pages 7 and 8, applicant comments that the present invention covers vehicle tires comprising removable plugs or inserts that comprise at least one perfume or fragrance that is given off due to wear, heat or friction when the tire is driven on. Examiner comments that claim 1 describes "scent" and is not limited to "perfume or fragrance".

Japan 873

Applicant states: "Japan 873 teaches perfume-sealed particles that might be incorporated into the rubber composition of the tire." Examiner agrees that Japan 873 (published 4-16-02) shows that a tire tread which releases a scent due to wear when

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the tire is used in a vehicle for driving was known in the tire art prior to applicant's filing date (4-10-04).

Applicant argues that Japan 873 fails to teach a tire plug of insert. This argument is not persuasive because Japan 873 teaches a tire tread and motivates one of ordinary skill in the art to form the tire tread of French 013, Canada 958 or Japan 908 such that the tread emits an desirable aroma. It is noted that "removable insert" reads on a replaceable tread as disclosed by French 013 or Canada 958 or member 6 of Japan 908. Applicant provides no convincing argument explaining why the replaceable tread of French 013 or Canada 958 is not an "insert". Also, applicant provides no convincing argument explaining why Japan 873's teaching to form a tread so as to emit aroma is not applicable to the replaceable tread of either French 013 or Canada 958 or the Japan 908's tread containing member 6.

Applicant argues that Berliner's suggestion of adding pheromone to perfume does not make up for the deficiencies of the other references. This argument is not persuasive. It is undisputed that Japan 873 teaches a tire tread containing perfume and rubber. Berliner, which teaches perfuming products such as new cars (column 7), adds to Japan 873's disclosure of a tire for a car by suggesting the use of pheromone when using perfume.

Applicant's arguments regarding French 340 are not persuasive since French 340 provides ample motivation (achieving visual monitoring of the degree of wear of the tire) to use a wear warning component in Japan 873's tire.

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Applicant's arguments regarding Mellet et al are not persuasive since Mellet et al suggests using reflective particles for a tread cover of a tire so as to provide decoration.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven D. Maki whose telephone number is (571) 272-1221. The examiner can normally be reached on Mon. - Fri. 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Steven D. Maki
December 29, 2006


STEVEN D. MAKI 12-29-06
PRIMARY EXAMINER

**Notice of Non-Compliant
Amendment (37 CFR 1.121)**

Application No.

10/822,049

Applicant(s)

ROSENBERGER, RONALD
JOHN

Examiner

Steven D. Maki

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1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

The amendment document filed on 08 December 2006 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121 or 1.4. In order for the amendment document to be compliant, correction of the following item(s) is required.

THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☐ 1. Amendments to the specification:
- ☐ A. Amended paragraph(s) do not include markings.
 - ☐ B. New paragraph(s) should not be underlined.
 - ☐ C. Other _____.
- ☐ 2. Abstract:
- ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
 - ☐ B. Other _____.
- ☐ 3. Amendments to the drawings:
- ☐ A. The drawings are not properly identified in the top margin as "Replacement Sheet," "New Sheet," or "Annotated Sheet" as required by 37 CFR 1.121(d).
 - ☐ B. The practice of submitting proposed drawing correction has been eliminated. Replacement drawings showing amended figures, without markings, in compliance with 37 CFR 1.84 are required.
 - ☐ C. Other _____.
- ☒ 4. Amendments to the claims:
- ☐ A. A complete listing of all of the claims is not present.
 - ☐ B. The listing of claims does not include the text of all pending claims (including withdrawn claims)
 - ☐ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended).
 - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
 - ☒ E. Other: Amendment to claim 10 does not indicate deletion of parts "c" and "d".
- ☐ 5. Other (e.g., the amendment is unsigned or not signed in accordance with 37 CFR 1.4):

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714.

TIME PERIODS FOR FILING A REPLY TO THIS NOTICE:

1. Applicant is given **no new time period** if the non-compliant amendment is an after-final amendment or an amendment filed after allowance. If applicant wishes to resubmit the non-compliant after-final amendment with corrections, the **entire corrected amendment** must be resubmitted.
2. Applicant is given **one month**, or thirty (30) days, whichever is longer, from the mail date of this notice to supply the correction, if the non-compliant amendment is one of the following: a preliminary amendment, a non-final amendment (including a submission for a request for continued examination (RCE) under 37 CFR 1.114), a supplemental amendment filed within a suspension period under 37 CFR 1.103(a) or (c), and an amendment filed in response to a *Quayle* action. If any of above boxes 1. to 4. are checked, the correction required is only the **corrected section** of the non-compliant amendment in compliance with 37 CFR 1.121.

Extensions of time are available under 37 CFR 1.136(a) only if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action.

Failure to timely respond to this notice will result in:

Abandonment of the application if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action; or

Non-entry of the amendment if the non-compliant amendment is a preliminary amendment or supplemental amendment.

Legal Instruments Examiner (LIE), if applicable

Telephone No.